

## **REMARKS/ARGUMENTS**

After Amended Appeal Brief was submitted by the Applicant on April 07, 2008, the Office issued another Final Office Action on June 13, 2008 (thus reopening prosecution) to address issues in the record that were previously made clear by way of interview summary (see Applicant's submission of October 31, 2007). The Office indicated that the Final Office Action of June 13, 2008 is to officially make the record clear by way of Office Action, and stated that the Final Office Action merely repeats the final rejection of September 25, 2007.

In a voicemail left with the Applicant's representative Anthony King, Examiner Blair Johnson indicated that the Applicant is required to submit a formal response to the Final Office Action of June 13, 2008. Further, Examiner Johnson indicated that should the Applicant wishes to continue the Appeal process, the Applicant must resubmit Notice of Appeal, and Appeal Brief. Examiner Johnson also indicated that no fee is required for filing such Notice of Appeal and Appeal Brief again, since the Applicant had already paid such fees in previous submissions of same on Dec. 10, 2007 and March 06, 2008, respectively.

This submission is in response to the Final Office Action of June 13, 2008, and repeats the amendment and remarks previously submitted on October 31, 2007.

The Applicant respectfully requests that the Examiner proceeds to respond to the attached Appeal Brief without further delay. Examiner's expedited review is herein earnestly requested.

### **Priority Claim**

It has been discovered that the U.S. patent application number to which the current application claims domestic priority to, was off by one digit in the specification as well as the Application Transmittal Sheet (both were submitted on the filing date of December 23, 2003). The applicant respectfully requests correction in this priority claim. The current application is a continuation-in-part of U.S. patent application 10/623,776 (filing date July 21, 2003), not 10/632,776 (filing date August 01, 2003).

### **35 USC 112**

Previously presented new claims 70-73 were rejected for minor formality errors. Claims 70, 71, and 74 have been amended. No new matter was entered.

### **Drawings**

The Office argued that the drawings did not show the second secondary line as recited in claim 61. Claim 61 has been amended, making this objection moot.

The Office argued that the drawings did not show the multiple laps as recited in claims 70-73. The applicant respectfully disagrees. The applicant respectfully submits that an embodiment of the multiple laps recitation is at least shown in drawing figures 17 and 18. In figure 17, two lifting cords entrain about a group of pulley rotors (1, 2, 3, and 5) in multiple laps. And the two lifting cords entrain about pulley rotors 1 and 5 twice in figure 17.

The Office argued that the drawings did not show fastener 201, which was not recited in the claims but mentioned in the specification. The specification has been amended to delete numeral indicator 201, making this objection moot. No new matter was entered.

### **35 USC 103(a)**

Claims 50-55, 58, and 61-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gertzon (2,594,637) in view of Kuhar (5,482,100). The applicant respectfully disagrees.

Examiner Johnson notified the applicant's representative on October 23, 2007 that claims 70-73 were inadvertently listed in the Final Office Action as having allowable subject matter. Instead, the Examiner indicated that the Final Office Action meant to reject claims 70-73 under 35 U.S.C. § 103(a) as being unpatentable over Gertzon (2,594,637) in view of Kuhar (5,482,100). As for this rejection, the applicant respectfully disagrees.

With respect to claims 50-55, 58, and 61-65, the applicant maintains his opinion as previously set forth and supported by secondary indicia of non-obviousness that the combination of the citations (if such combination is proper) would not have resulted in the claimed invention.

As for claims 70-73, the Office contended that, to entrain the cords around the rotors numerous times merely duplicated the arrangement in Gertzon and would have been obvious so

as to permit more cord to be wrapped on the spring motor without the coupling encountering the spring motor. The applicant respectfully disagrees. As previously argued by the applicant and evidenced in Affidavits, the arrangement of Gertzon and what's recited in claims 70-73 are clearly different. The applicant submits that claims 70-73 are not obvious over the citations.

### **Allowable Subject Matter**

The applicant thanks the Office for recognizing allowable subject matters in claims 56, 57, and 66.

According to the Examiner in a telephone call dated October 23, 2007, the Office inadvertently indicated allowable subject matters in claims 70-73.

### **Response to Examiner's Arguments to the Affidavits**

The Office is respectfully reminded that when an applicant submits evidence traversing a rejection, the examiner must make a fresh consideration of the patentability of the invention. The decision on patentability must be made based upon consideration of all of the evidence, including evidence cited by the examiner and the evidence submitted by the applicant. A decision to continue a rejection in the face of all the evidence must show that it was based upon the consideration of all the evidence. It is insufficient to state that the affidavit is insufficient to rebut the *prima facie* case. Rather, the office action should state that the conclusion of unpatentability was based upon the totality of the evidence. *In re Piasecki*, 223 USPQ 785 (Fed. Cir. 1984); *In re Semaker*, 217 USPQ 1 (Fed. Cir. 1983). MPEP 716.01(b).

The Office argued that the desirable characteristics indicated in Mr. Zerg's affidavit is not persuasive because such characteristics are not claimed and would be difficult to claim. The applicant disagrees. Mr. Zerg's affidavit provides factual and opinion evidence of unexpected results, among other secondary indicia of non-obviousness. The law does not require that applicants claim the unexpected results or properties. *In re Merchant*, 197 USPQ 785.

The Office further argued that the "desire to alleviate the dangling pull cord of Gertzon is exactly what led to the now widespread use of spring motors and storage spools for the lift cords." The applicant respectfully disagrees. The Office is respectfully asked to consider the

totality of the factual and opinion evidence presented in the affidavits. The totality of the evidence supports that it would not have been obvious at the time the invention was made to combine Gertzon and Kuhar to result in the claimed invention. In addition, the obviousness test is to consider whether it would have been obvious “at the time the invention was made,” not whether the motivation has led to a design that is “now in widespread use.” Further, the Office provided no evidence showing a nexus between what is now in widespread use and a proposed motivation. A design that is currently in wide spread use may have originated with the applicant’s product, and may have originated from elsewhere but dated later than the applicant’s invention date. Simply saying the claimed design is “now” in widespread use reveals nothing about whether it would have been obvious to combine two references.

In addition, the Office discredited any non-obviousness argument that a combination of prior art references would destroy a primary reference. The Office contended that if that were true, any combinations of teachings proposed 103 rejections would “destroy” the primary reference. The applicant respectfully disagrees. According to MPEP 2141.02 and 2143.01, prior art must be considered in its entirety, including disclosures that teach away from the claims, and that proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. Further, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). The applicant respectfully submits that the totality of the evidence in the record supports a finding of non-obviousness. The Office is requested to review and comment on the factual and opinion evidence previously presented with respect to unexpected result, teaching away, and how the primary reference would have been destroyed in the proposed combination, in particular.

The Office is also respectfully reminded that proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). Furthermore, “[k]nown disadvantage in old devices which would naturally discourage search for new inventions may be taken into account in determining obviousness.” *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). Here, evidence as previously presented supports that if one were motivated to modify the Gertzon device with the teaching of Kuhar, one would have eliminated the pulley system in Gertzon all together because Kuhar teaches

away from having complicated component parts. Having many component parts in a window blind system was a known disadvantage. Kuhar teaches having an easily adaptable way to have less component parts by using a spring motor alone. The applicant requests that the Office refer to arguments and affidavits previously presented for more detailed discussion.

As for evidence of commercial success, the Office contended that the success is a result of switching the main product from vinyl roller shades to pleated shades, and that the success is a reflection of the entire market, which made similar shift, and not in the currently claimed details of the blind. The applicant respectfully disagrees. Evidence presented in the record has adequately established a nexus between the claimed invention and the commercial success.

With respect to the declaration by applicant and by Mr. Chao, the Office contended that the declarants' opinion on whether they would have made such combination constitutes "hindsight." While the applicant agrees the Examiner may propose a different motivation to combine, the declarations by applicant and by Mr. Chao were in part to support unexpected results, and teaching away of Kuhar, and they show that the Office' proposed combination would not have been obvious. Again, the Office is respectfully asked to consider the totality of the evidence.

## **Conclusion**

Claims 50-73 are pending in this application. The applicant thanks Examiner Johnson for his dedication and helpful advice throughout the examination of this application. The applicant hereby respectfully requests allowance of all pending claims.

Respectfully submitted,

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